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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/817,314 | 03/26/2001 | Martin Vetterli | | 8869 |

7590 07/16/2002

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| EXAMINER |
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NGUYEN, PHU K

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| ART UNIT | PAPER NUMBER |
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2671

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No.
09/817,314

Applicant(s)

VETTERLI et al.

Examiner

Phu K. Nguyen

Art Unit

2671**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –****Period for Reply**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 26, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Phu K. Nguyen
 PHU K. NGUYEN
 PRIMARY EXAMINER
 GROUP 8403

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 2671

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-22 are rejected under the judicially created doctrine of double patenting over claims 1-45 of U. S. Patent No. 6,208,353 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Both of sets of claims are directed to the automated annotation of the displayed object with the same steps of display or arrangements.

Art Unit: 2671

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritt (5,689,717).

As per claim 1, Pritt teaches the claimed “computerized method for annotating an element of a view” comprising the steps of:

“Obtaining an identification of the element” (Pritt, figure 2);

“Relating the identification to annotating data associated with the element” (Pritt, figures 3A-3D); and

“Causing the data to be display” (Pritt, figure 4).

It is noted that Pritt does not explicitly teach “an identification” of the element as claimed. However, Pritt’s Object position (figure 6 - element 87) which essentially defines the object suggests such “identification” of the element as claimed. Thus, it would have been obvious to a

Art Unit: 2671

person of ordinary skill in the art at the time the invention was made to configure Pritt's method as claimed because object's position can positively define the object as well as its position.

Claims 2-20 add into claim 1 the details of annotation which Pritt suggests in his process (figures 4-7). Due to the similarity of claims 21-22 to claim 1-20 they are rejected under a similar reason. Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

Conclusion

5. Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:
(703)-308-9051 (**formal** communications intended for entry), Or:
(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**).
Hand-delivered responses should be brought to:
Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phu K. Nguyen, whose telephone number is (703)-305-9796 and can normally be reached Monday-Friday from 6:30 AM to 3 PM.
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

Phu K. Nguyen
Patent Examiner
Art Unit 2671

Phu K. Nguyen
PHU K. NGUYEN
PRIMARY EXAMINER
GROUP 2400